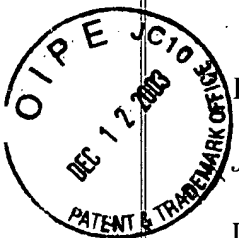


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of:

John R. Moody

Examiner: D.K. Schlak

U. S. Serial No. 10/004,823

Group Art Unit: 3653

Filed December 7, 2001

Docket No. 2324 (GP-00-41)

For: MODIFIED GRAVITY- FEED
MULTI-FOLD TOWEL
DISPENSER

#9
12-30-03

Mail Stop Appeal Brief - Patents
Commissioner for Patents
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BRIEF ON APPEAL

Sir:

Applicant submits herewith, in triplicate, its *Appeal Brief* in the above-noted United States Patent Application. This *Appeal* is from the *Final Rejection* of August 22, 2003. A *Notice of Appeal* was submitted on November 24, 2004. Please charge the fee for the *Brief*, as well as any other fees due in this case to our Deposit Account No. 50-0935. If any extensions of time are required, please consider this paper a *Petition* therefore and charge our account as aforesaid.

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1. REAL PARTY IN INTEREST

Georgia-Pacific Corporation, 133 Peachtree Street, N.E., Atlanta Georgia 30303 is the real party in interest in this patent application. The *Assignment* was recorded at Reel 012357 / Frame 0704 on August 21, 2001.

2. RELATED APPEALS AND INTERFERENCE

There are no related appeals or interferences known to Applicant or its legal representatives which will affect or be affected by or having a bearing on the Board's decision in this case.

3. STATUS OF CLAIMS

Claims 1-22 are pending in this application. A complete listing of the *Claims on Appeal* is provided in Appendix A hereto.

4. STATUS OF AMENDMENTS

All amendments have been entered; no amendments have been filed subsequent to the *Final Rejection* of August 22, 2003.

Drawing changes were proposed June, 2003. No action on the proposals has been taken.

5. SUMMARY OF INVENTION

The present invention relates to improvements in gravity-feed paper towel dispensers and in a particular embodiment to an adapter plate **40** to shorten the dispensing aperture to a length, **L'**, of from about 80 to 90 percent of the transverse length, **L**, of folded towels dispensed through the aperture.

Claim 1 is representative of the subject matter on appeal:

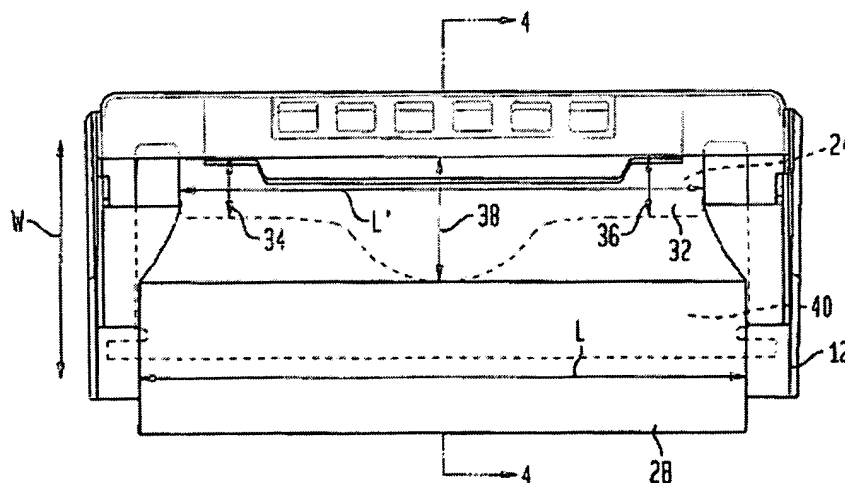
In a gravity-feed towel dispenser for dispensing C-fold and interfolded towels having a transverse length, **L**, through an elongated bottom dispensing aperture having a length of **L** or greater, said towel dispenser

including means for defining a top portion, a front wall, a back wall and a pair of side walls of said towel dispenser, as well as a bottom portion collectively defining an interior for receiving a stack of C-fold or interfolded towels to be dispensed through said aperture, said bottom portion of said towel dispenser defining said elongated bottom dispensing aperture; an adapter plate for securing to said bottom portion of said towel dispenser configured to abridge the length of said dispensing aperture to a length L' of from about 80 percent to about 90 percent of said transverse length, L , of said C-fold or interfolded towels.

Details are appreciated by considering **Figure 2** of the application (appearing below) and the text, as filed, at page 6, line 28, through page 7, line 12:

Thus the present invention provides a unique configuration for a gravity-feed towel dispenser generally having the characteristics that the transverse length of the dispensing aperture of the towel dispenser is abridged to a length L' of from about 80 to about 90 percent of the transverse length L of interfolded towels to be dispensed there through. In a preferred embodiment there is provided an adapter plate to render a prior art gravity feed towel dispenser to modify the geometry of a prior art gravity-feed towel dispenser to the configuration of the present invention. A particularly preferred adapter plate comprises a pair of upwardly inclined terminal portion which project laterally and upwardly at each end of the adapter plate. The plate is generally elongated and rectangular as shown in **Figure 5**. The elongated dispensing aperture in a particularly preferred embodiment is abridged to a length L' of about 85 percent of the transverse length L of the interfolded towels. That is to say, a nine inch aperture length is provided for a 10 1/2 inch towel, for example.

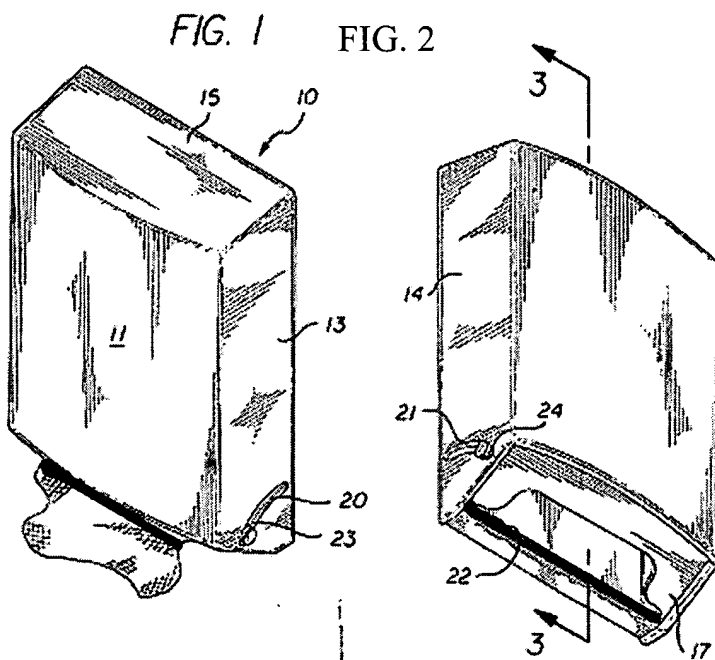
FIG. 2



6. ISSUES

In the final rejection appealed from, all previous rejections were withdrawn except the rejection on the basis of 35 USC §102(b) over United States Patent No. 5,642,836 to *Merriweather*. While the rejection relies on *Merriweather* '836, it is plain that the '836 patent does not disclose a gravity feed paper towel dispenser having an aperture having a length, L' , of 80-90 percent of the length, L , of towels to be dispensed as can be seen by comparing **Figures 1 and 2** of the '836 patent, reproduced below:

(PRIOR ART)



The towel on the left is clearly of lesser dispensing length than aperture **22** on the right. Relative lengths are indicated in red.

The substance of the issues on appeal is accordingly claim construction.

An issue as to all claims is one of general claim construction, that is, whether or not the claims require a towel of greater length than the dispensing aperture, particularly where

the aperture is about 80-90 percent of the dispensing length of the towels. Applicant believes that the claims, properly construed, clearly require this feature.

As to specific claims, the Examiner has improperly construed each independent claim.

7. GROUPING OF CLAIMS

For the reasons discussed in more detail below:

Claims 1-8 stand or fall together;

Claims 9-10 stand or fall together;

Claims 11-18 stand or fall together;

Claims 19-20 stand or fall together; and

Claims 21-22 stand or fall together.

8. ARGUMENT

All of the pending independent claims in this patent application require dispensing a towel having a transverse length, L , which is greater than the transverse length, L' , of a dispensing aperture. The Examiner has, on the one hand, taken the position that the claims do not require a towel of length, L , and, on the other hand, concluded that *Merriweather* '836 "could be used" for dispensing towels having the recited length and therefore the reference anticipates the claim. The *Final Rejection* provides in relevant part:

No positive recitation of the towels and their length has been made in any of the claims. In each independent claim is set forth a dispenser with sides, top, bottom, adapter plate, etc., and the towels are only indirectly described in an attempt to set forth what the device is to be used for. As *Merriweather* comprises all of the elements of the claims, it certainly could be used "for dispensing ... towels having a transverse length, L ," which is greater than the

length of the aperture in the adapter plate. There is no structural evidence to suggest otherwise, and therefore Merriweather's device is, just as much as the instant invention, "for dispensing ... towels having a transverse length, L," which is greater than the length of the aperture in the adapter plate, and in a specific example, Merriweather's device can easily be used "for dispensing" towels wherein the aperture would be 90% of the transverse length, L. As the devices are structurally equivalent insofar as the claims of the instant invention teach nothing in any limitative sense which is not anticipated by Merriweather, the claims should not and cannot stand or fall in applicability based upon what size towels a user might or might not decide to put inside the dispenser.

Final Rejection, p. 4. Both positions of the Examiner are untenable.

Turning first to claim construction, the only independent claims in this case, Claims 1, 11 and 21, appear below:

1. In a gravity-feed towel dispenser for dispensing C-fold and interfolded towels having a transverse length, L, through an elongated bottom dispensing aperture having a length of L or greater, said towel dispenser including means for defining a top portion, a front wall, a back wall and a pair of side walls of said towel dispenser, as well as a bottom portion collectively defining an interior for receiving a stack of C-fold or interfolded towels to be dispensed through said aperture, said bottom portion of said towel dispenser defining said elongated bottom dispensing aperture; an adapter plate for securing to said bottom portion of said towel dispenser configured to abridge the length of said dispensing aperture to a length L' of from about 80 percent to about 90 percent of said transverse length, L, of said C-fold or interfolded towels.
11. A gravity-feed towel dispenser for dispensing interfolded towels of a transverse length, L, through an elongated bottom dispensing aperture including means for defining a top portion, a front wall, a back wall, and a pair of side walls of said towel dispenser as well as means for defining a lower surface defining a periphery of said dispensing aperture thereby defining said aperture, wherein said elongated dispensing aperture is of transverse length, L', of from about 80 percent to about 90 percent of the transverse length, L, of said interfolded towels.
21. In a gravity-feed towel dispenser for dispensing C-fold and interfolded towels having a transverse length, L, through an elongated bottom dispensing aperture having a length of L or greater, said towel dispenser including means for defining a top portion, a front wall, a back wall and a

pair of side walls of said towel dispenser, as well as a bottom portion collectively defining an interior for receiving a stack of C-fold or interfolded towels to be dispensed through said aperture, said bottom portion of said towel dispenser defining said elongated bottom dispensing aperture, said dispenser being of the class that are moved forwardly for reloading; the improvement comprising an adapter plate secured to said bottom portion of said towel dispenser configured to abridge the length of said dispensing aperture to a length L' of from about 80 percent to about 90 percent of said transverse length, L , of said C-fold or interfolded towels, wherein the adapter plate is pivotally secured to the dispenser to accommodate reloading.

Claims 1 and 21 are Jepson claims. Interpretation of such claims ordinarily includes the preamble recitation, and certainly does as to a feature recited after transition to the "improvement" portion of the claim. Here the relationship between L and L' is recited in the last few lines of the independent claims as a salient feature and cannot be ignored. Such recitation in the claim is undoubtedly a part of the claim as is seen from the following cases.

It is noted that Claim 1 does not have the traditional "improvement comprising" language; however, this claim is nevertheless a Jepson claim because it recites an improvement over existing dispensers; that is, shortening the aperture with an adapter plate.

In *Rowe v. Dror*, 42 USPQ2d 1550, 1553-4 (CAFC 1997) the Court reiterated that in Jepson-type claims the structural limitations of the preamble are an integral part of the Claim:

Inspection of the entire record in this case reveals that "angioplasty" is, in fact, a structural limitation of Rowe's claims. To begin with, the form of the claim itself, the so-called "Jepson" form, suggests the structural importance of the recitations found in the preamble. The Jepson form allows a patentee to use the preamble to recite "elements or steps of the claimed invention which are conventional or known." 37 C.F.R. 1.75(e) (1996). When this form is employed, the claim preamble defines not only the context of the claimed invention, but also its scope. See *Pentec, Inc. v. Graphic Controls, Corp.*, 776 F.2d 309, 315, 227 USPQ 766, 770 (Fed. Cir. 1985) ("Although a preamble is impliedly admitted to be prior art when a Jepson claim is used, . . . the claimed invention consists of the preamble in combination with the improvement.") (citations omitted); United States Patent and Trademark Office, Manual of Patent Examining Procedure Section 608.01(m) (6th ed. rev. Sept. 1995) ("[The Jepson form of claim] is to be considered a combination claim. The

preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination."'). Thus, the form of the claim itself indicates Rowe's intention to use the preamble to define, in part, the structural elements of his claimed invention. The device for which the patent claims "an improvement" is a "balloon angioplasty catheter."

See, also, Epcon Gas Systems Inc. v. Bauer Compressors Inc., 61 USPQ2d 1470, 1475 (CAFC 2002) wherein the Court noted:

Jepson form allows a patentee to use the preamble to recite "elements or steps of the claimed invention which are conventional or known." *Kegel Co. v. AMF Bowling, Inc.*, 127 F.3d 1420, 1426, 44 USPQ2d 1123, 1127 (Fed. Cir. 1997) (quoting 37 C.F.R. § 1.75(e) (1996)). However, in *Rowe v. Dror*, this court stated that "[w]hen this form is employed, the claim preamble defines not only the context of the claimed invention, but also its scope." 112 F.3d 473, 479, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997). According to Rowe and Kegel, the fact that the patentee has chosen the Jepson form of the claim evidences the intention "to use the preamble to define, in part, the structural elements of his claimed invention." *Id.*; Kegel, 127 F.3d at 1426, 44 USPQ2d at 1127. Thus, the preamble is a limitation in a Jepson-type claim. See *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 315, 227 USPQ 766, 770 (Fed. Cir. 1985); 3 Donald S. Chisum, *Chisum on Patents* §8.06[1][d] n.21 (Supp. 1999).

Although Epcon disputes that claims 2 and 16 of the '455 patent are in Jepson form, the prosecution history shows that Epcon acquiesced in the Examiner's statement that the claims were Jepson claims. Epcon amended claim 16 to correctly put it in Jepson format, and initially presented claim 2 in correct Jepson format in the same amendment, stating, "[t]he herein amendments are believed to address all of the Examiner's 35 USC 112 objections to the claims." On this record, there can be no real debate that the claims are presented in Jepson format.

Because claims 2 and 16 are in Jepson format, the preamble helps define the scope of the invention.

Proper construction of Claim 11 also includes the towel length, *L*, since its relationship with *L'*, the aperture length, is relied upon for patentability. In this respect, *Invitrogen Corp. v. Biocrest Manufacturing L.P.*, 66 USPQ2d 1631, 1635 (CAFC 2003) is pertinent:

In the first place, the district court correctly discerned that the preamble in this patent acts as a limitation. The district court reasoned: "In response to the Examiner's rejection, the applicants for the '797 patent amended the claims to include the 'improved competence' language" and "cannot now disavow the claim limitation of 'improved competence' because it was clearly essential for procuring the patent." *Id.* at 4. This court has stated that "clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention." *Catalina Mktg. Int'l Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808-809, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002) (citing *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1375, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001)).

Here, the towel length recited in the preamble is important in the claim as it is later recited in the body of Claim 11.

In this application, the disputed elements are not only in the preamble but also appear in the body of the claims, making clear that towel length is part of the claimed combination. The Examiner points out that the claimed combination is absent when the towel dispenser is empty. That observation is a flawed basis on which to construe a claim since any claimed combination is absent when the article or machine is disassembled. Does that change the claim meaning? Does that absolve the infringer from infringement? Certainly not.

The claim construction urged by the Examiner is clearly flawed as to the claim limitation of towel dispensing length and the Office Action should be reversed for this reason alone, but there are numerous additional reasons why the Office Action should be reversed and the claims passed to issue.

As to the Examiner's position that *Merriweather* '836 "could be used" for dispensing towels of a certain relative length, it is believed this statement is a clear marker that the "all elements rule" is not met by the reference and that the claims are patentable. As noted in *In re Robertson*, and the cases cited therein, the all elements rule requires that **all** elements of a claim must appear in a single reference before that claim is anticipated:

Anticipation requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

See 49 USPQ2d 1949,1950 (CA FC 1999).

Merriweather '836 in no way discloses or suggests the claimed towel dispensing length and its relationship to aperture length; the reference in fact shows towels **shorter** than the aperture length. The benefits of a 80-90 percent abridged aperture are apparent from Examples 446-1055 and 1600-2160 of the *Moody* application which compare the dispensing effectiveness of a dispenser with a prior art configuration and a dispenser of the present invention. As shown below, the present invention prevented towels from unintentionally falling out of the dispenser nearly 100% of the times tested. Such results greatly reduce waste.

The data presented on pages 8-9 of the specification is summarized in Table 2 below:

Configuration: Example Nos.	% occurrence dispersing more than one towel	% occurrence towels falling out	Numbers of towels on floor
Prior Art: Examples 1-445 and 1055-1599	0.9	7	163
Present Invention: Examples 446- 1055 and Examples 1600- 2160 combined	0	0.001	1

Turning to specific claims, Claim 1 requires (in addition to the foregoing relative dimensions) a bottom and an adapter plate. The Examiner argues that *Merriweather* '836 has such disclosure:

Applicant alleges that *Merriweather* does not comprise a bottom and an adapter plate. Certainly the side walls and front and back walls have bottoms. If the adapter plate were removed from *Merriweather*'s device, it would still

have a bottom defined by the bottoms of these walls. Every three dimensional body has a bottom. Just like Merriweather's device has sides, and a top, and an inside and an outside, it has a bottom which is only partially substantiated by the adapter plate.

The Examiner again misconstrues claim language. If the bottom is removed from the *Merriweather* '836 device, it has no "bottom", i.e., with a support surface -- clearly a "must have" for a gravity feed dispenser. Proper construction of claim 1 thus reasonably requires a bottom capable of supporting the towels against gravity and defining a dispensing aperture as well as an adapter plate as a separate element. Proper construction of a claim must be in light of the specification and the Examiner has instead created an inoperable hypothetical construction.

Properly construed, Claim 1 is not remotely suggested by *Merriweather* '836.

Claim 11 differs from Claim 1 in two important respects: (1) it is directed to a dispenser *per se* while Claim 1 is an adapter plate/dispenser combination and (2) Claim 11 has means plus function language as to the lower surface of the bottom defining the aperture which must be interpreted in accordance with 35 USC §112, ¶6. *See* MPEP §2181. *Note also, In re Donaldson Co.*, 29 USPQ2d1845 (CAFC 1994), at pages 1848-1850:

The plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure. Paragraph six does not state or even suggest that the PTO is exempt from this mandate, and there is no legislative history indicating that Congress intended that the PTO should be. 3 Thus, this court must accept the plain and precise language of paragraph six. *See* Mansell *supra*; *see also* Diamond v. Chakrabarty, 447 U.S. 303, 308 [206 USPQ 193] (1980) ("courts 'should not read into the patent laws limitations and conditions which the legislature has not expressed' "), quoting United States v. Dubilier Condenser Corp. , 289 U.S. 178, 199 [17 USPQ 154] (1933). Accordingly, because no distinction is made in paragraph six between prosecution in the PTO and enforcement in the courts, or between validity and infringement, we hold that paragraph six applies regardless of the context in which the interpretation of means-plus-function language arises, i.e., whether as part of a patentability determination in the PTO or as part of a validity or

infringement determination in a court. 4 To the extent that *In re Lundberg*, 244 F.2d 543, 113 USPQ 530 (CCPA 1979), *In re Arbeit*, 206 F.2d 947, 99 USPQ 123 (CCPA 1953), or any other precedent of this court suggests or holds to the contrary, it is expressly overruled.

The Commissioner argues that his interpretation is entitled to deference in view of what the Commissioner alleges is the PTO's sweeping and long-standing practice of not applying paragraph six during examination. We disagree. The fact that the PTO may have failed to adhere to a statutory mandate over an extended period of time does not justify its continuing to do so. In addition, paragraph six facially covers every situation involving the interpretation of means-plus-function language, and the Commissioner's attempts to create an ambiguity in paragraph six where none exists are to no avail. The fact that paragraph six does not specifically state that it applies during prosecution in the PTO does not mean that paragraph six is ambiguous in this respect. Quite the contrary, we interpret the fact that paragraph six fails to distinguish between prosecution in the PTO and enforcement in the courts as indicating that Congress did not intend to create any such distinction.

In addition, section 112 as a whole relates to requirements for the specification and claims without regard to whether a patent or patent application is involved. Moreover, section 112 is found in Chapter 11 of Title 35, titled "Application for Patent," which supports our holding that section 112, paragraph six, governs the interpretation of "means" clauses in a claim for a combination when being examined in pending applications.

The Commissioner argues that Congress enacted paragraph six to codify the "reverse doctrine of equivalents" for means-plus-function claim language, a claim interpretation tool which finds application only in the litigation context, wherefore Congress must have intended paragraph six to apply only in the context of post-issuance infringement and validity actions. We see no merit in this imaginative reasoning, and no support for it has been cited. The record is clear on why paragraph six was enacted. In *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 [71 USPQ 175] (1946), the Supreme Court held that means-plus-function language could not be employed at the exact point of novelty in a combination claim. Congress enacted paragraph six, originally paragraph three, to statutorily overrule that holding. See *In re Fuetterer*, 319 F.2d 259, 264 n.11, 138 USPQ 217, 222 n.11 (CCPA 1963) (noting that it was Congress's intent to restore the law regarding broad functional language in combination claims to its state prior to *Halliburton*). The fact that the question of how to treat means-plus-function language came to Congress's attention through the context of infringement litigation does not suggest that Congress did not intend paragraph six to apply to all interpretations of means-plus-function claim language. Furthermore, there is no legislative history suggesting that Congress's purpose in enacting paragraph six was to codify the reverse doctrine of equivalents,⁵ and thus there is no reason to believe that Congress intended to limit the application of paragraph six to post-issuance claim interpretation.

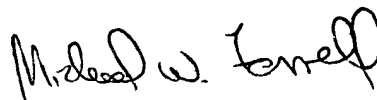
The phrase in Claim 11 "...means for defining a lower surface defining a periphery of said dispensing aperture thereby defining said aperture, wherein said elongated dispensing aperture is of transverse length, L', of from about 80 percent to about 90 percent of the transverse length, L, of said interfolded towels." must be construed in light of the specification as required by statute. The Examiner has failed to construe Claim 11 as required by §112, ¶6 and the rejections of Claim 11 should be reversed for this reason.

Claims 9, 10, 19 and 20 recite specific geometric features of the dispensing apertures of the various embodiments of the invention. Specifically, the width or span of the aperture is specified relative to the width of the towels dispensed. *Merriweather* '836 in no way suggests the geometry claimed in these claims and accordingly, these claims are allowable independently of their parent claims.

Claim 21 requires, in addition to the features described in connection with Claim 1, a dispenser of the class that is moved forwardly for reloading and which has a pivotally secured adapter plate. The art does not suggest these features and this claim is accordingly believed allowable independently of Claims 1 and 11.

All claims should be allowed.

Respectfully submitted,



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